APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,486	08/31/2000	James J. Crow	MTV0017US	4808

33031   7590   06/13/2008
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ART UNIT	PAPER NUMBER
2157	

MAIL DATE	DELIVERY MODE
06/13/2008	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte JAMES J. CROW

_____

Appeal 2008-0593
Application 09/653,486
Technology Center 2100

_____

Decided: June 12, 2008

_____

Before JEAN R. HOMERE, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

    This is a decision on appeal under 35 U.S.C. § 134(a) from the

Examiner's rejection of claims 1-20. Claims 21-33 have been cancelled.

We have jurisdiction under 35 U.S.C. § 6(b).

    We AFFIRM.

THE INVENTION

 The disclosed invention relates generally to the fields of digital communications and computer maintenance. More particularly, Appellant's invention is directed to a system and method for configuring personal computer systems for broadband communication (Spec. 1).

 Independent claim 1 is illustrative:

  1. A method of converting a personal computer for communicating information on a broadband communication network, said personal computer having a user and a physical location, comprising:

   determining whether said physical location falls within a set of service boundaries for said broadband communication network;

   if said physical location falls within said service boundaries, electronically offering said user access to said broadband communication network;

   receiving from said user an electronic order accepting said offer;

   remotely qualifying said personal computer for said broadband communication network by determining whether said personal computer meets predetermined acceptance criteria for use of said broadband communication network; and

   fulfilling said order by initiating an automation agent on said personal computer to interact with the user and thereby configure a modem coupled to said personal

computer for access to said broadband communication
network, and

automatically configuring an asset of said
broadband communication network to communicate
with said personal computer, wherein said automatically
configuring said asset is performed by an automation
server of said broadband communication network.

THE REFERENCES

The Examiner relies upon the following references as evidence in
support of the rejections:

Wang	US 6,636,505 B1	Oct. 21, 2003
		(filed May 28, 1999)
Bahlmann	US 6,684,242 B1	Jan. 27, 2004
		(filed May 2, 2000)

THE REJECTIONS

Claims 1-3, 7, 9-13, and 17-20 stand rejected under 35 U.S.C.
§ 102(e) as being anticipated by Wang.

Claims 4-6, 8, and 14-16 stand rejected under 35 U.S.C. § 103(a) as
being unpatentable over Wang in view of Bahlmann.

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art
reference that discloses, either expressly or inherently, each limitation of a

claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

ISSUE(S)

We have determined that the following issues are dispositive in this appeal:

(1) Whether Appellant has shown that the Examiner erred in finding that Wang discloses "initiating an automation agent on said personal computer to interact with the user and thereby configure a modem coupled to said personal computer for access to said broadband communication network," as claimed.

(*see* representative independent claim 1 and the equivalent language recited in independent claim 11).

(2) Whether Appellant has shown that the Examiner erred in finding that Wang discloses "automatically configuring an asset of said broadband communication network to communicate with said personal computer, wherein said automatically configuring said asset is performed by an automation server of said broadband communication network," as claimed.

(*see* representative independent claim 1 and the equivalent language recited in independent claim 11).

      (3) Whether Appellant has shown that the Examiner erred in
          combining Wang with Bahlmann.

(*see* dependent claims 4 and 14).

<div align="center">Grouping of Claims</div>

      Appellant only includes claims 1, 4, 11, and 14 under the grounds of
rejection section at the top of page 4 of the principal Brief. However, under
the "CONCLUSION" heading on page 9 of the Brief, Appellant clearly
states: "[f]or the above reasons, Appellant respectfully submits that the
rejection of pending Claims 1-20 is unfounded." Therefore, we consider
claims 1-20 as being before us on appeal.

      Regarding the anticipation rejection, Appellant's arguments are
primarily directed to independent claim 1. Appellant states that
"independent claim 11 is patentably distinguishable over the cited sections
of Wang for the same or similar reasons claim 1 is patentably
distinguishable over the cited sections of Wang." (App. Br. 7, ¶3).
Appellant does not present separate arguments for any of dependent claims
2, 3, 7-10, 12, 13, and 17-20 that also stand rejected as being anticipated by
Wang. Pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii), we
select independent claim 1 as being representative of the group including
claims 1-3, 7, 9-13, and 17-20 that stand rejected as being anticipated by
Wang.

Regarding the obviousness rejection of dependent claims 4-6, 8, and
14-16, Appellant only presents arguments directed to claims 4 and 14. Each
of claims 4 and 14 recite the limitation of "wherein said broadband
communication network is a cable network." Therefore, we select claim 4
as the representative claim for the group including claims 4-6, 8, and 14-16
that stand rejected as being unpatentable over Wang in view of Bahlmann.
See 37 C.F.R. § 41.37(c)(1)(vii).

After considering the record before us, it is our view that Wang (or the
combination of Wang as modified by Bahlmann), discloses each limitation
argued by Appellant, as detailed in our analysis below. In light of *KSR Int'l
Co. v. Teleflex, Inc.* (and its progeny in the Federal Circuit), it is also our
view that the Examiner has properly combined Wang with Bahlmann, as
discussed *infra*.

ANALYSIS

Issue 1

We consider the question of whether Appellant has shown that
the Examiner erred in finding that Wang discloses the following
limitations:

> initiating an automation agent on said personal computer to
> interact with the user and thereby configure a modem coupled
> to said personal computer for access to said broadband
> communication network, and

(claim 1).

The Examiner relies on Wang, column 5, line 20 through column 6, line 65, as purportedly teaching the aforementioned limitations.

Appellant acknowledges that the cited section of Wang teaches user interaction during the automatic provisioning of a modem (App. Br. 5, ¶3). However, Appellant contends that "the cited section does not teach or fairly suggest initiating an agent on said personal computer as required by claim 1, let alone initiating an agent to interact with the user and thereby configure a modem." (*Id.*)

<div align="center">Claim Construction</div>

During prosecution, "the PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). Regarding the claim term "automation agent," Appellant points to Figs. 1 and 2 and page 8, lines 13-15 (App. Br. 3, ¶1). For convenience, we reproduce those lines here:

> The automation agent 4 within the subscriber computer **1** is activated to perform this workflow process which represents a series of tasks that have been tailored for the specific broadband access network **8** and service offering desired.

(Spec. 8, ll. 13-15).

In light of the above support found in Appellant's Specification, we broadly but reasonably construe the claim term "automation agent" to encompass a program or other software that acts on behalf of a user to facilitate connection to a network.

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We find several such "automation agents" disclosed by Wang as software programs represented by service icons that are selected by the user to facilitate connection to a particular network, such as "AOL-premium," as clearly shown in Wang's Figure 6. Wang further discloses the function of the CPE 110 service selection application (i.e., agent), as follows:

> FIG. 6 shows an example of a graphical interface for a CPE 110 service selection application. The user need only select the services and the selection can be multiple, for example to have concurrent connections to different ISPs and/or corporate Intranet.

(Wang, col. 10, ll. 55-59).

In particular, we note that the term "CPE," as disclosed by Wang, represents "[a] subscriber's customer premises equipment (CPE) 110 include[ing] a personal computer that has an internal ADSL modem." (Col. 5, ll. 25-27). Because establishing a connection to an Internet Service Provider (ISP) necessarily involves at least some level of configuration of the internal ADSL modem, it is our view that Wang discloses "initiating an automation agent on said personal computer to interact with the user and thereby configure a modem coupled to said personal computer for access to said broadband communication network," as claimed (*see* representative claim 1).

<center>Issue 2</center>

We consider the question of whether Appellant has shown that the Examiner erred in finding that Wang discloses the following limitations:

<center>8</center>

>automatically configuring an asset of said broadband
>communication network to communicate with said personal
>computer, wherein said automatically configuring said asset is
>performed by an automation server of said broadband
>communication network.

(claim 1).

In particular, Appellant avers that the terms "modem" and "asset" are separate entities, as claimed:

>Importantly, claim 1 recites configuring a modem coupled to
>said personal computer for access to the broadband
>communication network that contains the *asset*. In other words,
>the modem is configured to enable access to the broadband
>communication network that contains the *asset*. Claim 1 makes
>clear that the modem and the asset are separate entities since the
>asset is contained in the broadband communication network for
>which the modem is configured.

(App. Br. 6, last paragraph).

When we look to Appellant's Specification for *context*, we find the term "asset" is used to broadly encompass "all physical network assets." (Spec., as amended, p. 10, ¶1).

After considering the record before us, it is our view that Appellant is imputing an overly narrow interpretation to the claim term "asset" as excluding a modem, not supported by any special definition in the Specification. To the contrary, we find the claim term "asset" broadly but reasonably reads on *any* network asset, including a "modem" coupled to a personal computer that is part of a network, as disclosed by Wang:

> Once the network 60 is configured, the ADSL modem in the
> CPE 110 is automatically configured for ADSL service by the
> server 130 over the communication channel 120.

(Wang, col. 5, ll. 43-46).

Therefore, it is our view that Wang discloses "automatically configuring an asset of said broadband communication network to communicate with said personal computer, wherein said automatically configuring said asset is performed by an automation server of said broadband communication network," as claimed (*see* representative claim 1).

For at least the aforementioned reasons, we find the weight of the evidence supports the Examiner's position that Wang is an anticipatory reference. Because we conclude that Appellant has not shown the Examiner erred, we sustain the Examiner's rejection of representative independent claim 1 (and claims 2, 3, 7, 9-13, and 17-20 that fall therewith), as being anticipated by Wang.

Obviousness under 35 U.S.C. § 103

PRINCIPLES OF LAW

"What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under *§ 103*." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *Id.* at 1740. Appellant has the burden on appeal to

the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellant's Briefs to show error in the proffered prima facie.

<center>Issue 3</center>

We consider the question of whether Appellant has shown that the Examiner erred in combining Wang with Bahlmann. We note that Appellant does not contest the Examiner's finding that Bahlmann teaches a broadband communication network that is a cable network, as claimed (*see* claims 4 and 14).

Regarding Appellant's arguments against the combinability of the cited references (App. Br. 7-9), our reviewing court has reaffirmed that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. at 1739).

This reasoning is applicable here. The Examiner has combined familiar elements taught by Wang, i.e., a broadband network, a computer, and a modem (*see* Wang's Figures 1 and 2), with Bahlmann's teaching of a

broadband communication network that is a cable network connected to a cable modem (col. 3, ll. 37-48). We find the Examiner's proffered combination of such familiar elements would have yielded predictable results. Appellant has not rebutted the Examiner's legal conclusion of obviousness by showing that the claimed combination of familiar elements produces any new function. Moreover, Appellant has not provided any factual evidence of secondary considerations, such as unexpected or unpredictable results, commercial success, or long felt but unmet need. Accordingly, we find Appellant's arguments unpersuasive that the cited references have been improperly combined by the Examiner.

For at least the aforementioned reasons, we conclude that Appellant has not shown the Examiner erred in establishing prima facie obviousness in rejecting representative claim 4. Therefore, we sustain the Examiner's rejection of claim 4 (and claims 5, 6, 8, and 14-16 that fall therewith) as being unpatentable over Wang in view of Bahlmann.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellant has not met his burden of showing that the Examiner erred in rejecting claims 1-3, 7, 9-13, and 17-20 under 35 U.S.C. § 102(e) for anticipation.

Likewise, we conclude that Appellant has not met their burden of showing that the Examiner erred in rejecting claims 4-6, 8, and 14-16 under 35 U.S.C. § 103(a) for obviousness.

DECISION

We affirm the Examiner's decision rejecting claims 1-3, 7, 9-13, and 17-20 under 35 U.S.C. § 102(e) for anticipation.

We affirm the Examiner's decision rejecting claims 4-6, 8, and 14-16 under 35 U.S.C. § 103(a) for obviousness.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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